

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM H. TEW, III

Appeal 2007-1596
Application 09/996,707
Technology Center 1700

Decided: September 26, 2007

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1-19 and 22-26, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellant, the invention is directed to a vegetative produce handling machine which includes at least one stationary vegetative produce contacting surface that is covered with foam padding to reduce the

bruising of the vegetative produce, where the foam padding is formed with an anti-microbial agent to retard the growth of microbes within the padding (Br. 5).¹ Independent claim 15 is illustrative of the invention and a copy of this claim is reproduced below:

15. A vegetative produce handling machine, comprising:

at least one stationary vegetative produce-contacting surface; and

a foam padding covering at least a portion of said stationary vegetative produce-contacting surface of the machine, wherein said foam padding is intended to reduce bruising of the vegetative produce contacting the stationary surface and where said foam padding is formed with an anti-microbial agent to retard the growth of microbes on the padding.

The Examiner has relied upon the following prior art references as evidence of obviousness:

Bowman	US 2,012,655	Aug. 27, 1935
Moore	US 2,195,371	Mar. 26, 1940
Newhall	US 2,534,205	Dec. 12, 1950
Smith	US 2,635,267	Apr. 21, 1953
Schnider	US 2,880,432	Apr. 07, 1959
Kurtz	US 3,242,008	Mar. 22, 1966
Butterworth	US 3,449,779	Jun. 17, 1969
Ross	US 3,651,922	Mar. 28, 1972
Eguchi (JP '841), (as translated)	JP 6-246841	Sep. 06, 1994
Zabron	US 5,906,269	May 25, 1999
Boyle	US 6,309,741 B1	Oct. 30, 2001

ISSUES ON APPEAL

Claim 7 stands rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement (Answer 3).

¹ We refer to and cite from the "Supplemental Appeal Brief" dated May 27, 2005.

The following rejections under 35 U.S.C. § 103(a) have also been presented for our review in this appeal:

- (1) claims 15 and 19 over Smith in view of either Zabron or JP ‘841 (Answer 4);
- (2) claims 15 and 19 over Schnider in view of either Zabron or JP ‘841 (Answer 5);
- (3) claims 15-19 over Ross in view of either Zabron or JP ‘841 (*id.*);
- (4) claims 15-19 over Boyle in view of JP ‘841 (Answer 6);
- (5) claims 1, 6-11, 22, 24, and 26 over Moore in view of Ross and either Zabron or JP ‘841 (Answer 7);
- (6) claim 12 over Moore in view of Ross and either Zabron or JP ‘841, further in view of Kurtz (Answer 9);
- (7) claim 13 over Moore in view of Ross and either Zabron or JP ‘841, further in view of Bowman (*id.*);
- (8) claim 14 over Moore in view of Ross and either Zabron or JP ‘841, further in view of Butterworth (Answer 10); and
- (9) claims 2-5, 23, and 25 over Moore in view of Ross and either Zabron or JP ‘841, further in view of Newhall (*id.*).

Appellant contends that a *prima facie* case of lack of written description has not been established by the Examiner, since the relationship between abrasion resistance of the foam and water absorption/retention was within the possession of Appellant (Br. 11, citing the Specification 1:15-27 and 9:20-23; Reply Br. 5-6).

Appellant admits that many of the primary references (specifically Smith, Schnider, and Boyle) disclose the use of foam padding on certain surfaces of a produce machine to reduce or eliminate bruising of the

vegetables/fruits, but contends that none of these references teach or suggest the need to prevent the growth of bacteria (Br. 14, 16, and 20-21). Appellant further contends that Moore lacks any teaching or suggestion to use padding to prevent bruising of the produce (Br. 22).

Appellant contends that Zabron does suggest the use of an anti-microbial agent with a conveyor belt, but lacks any teaching or suggestion to use such a belt as padding to mitigate the bruising of fruits and vegetables (Br. 14). Appellant further contends that it is improper to expand the teachings of Zabron to materials other than belts (Br. 14-15; Reply Br. 6-7).

Appellant contends that JP '841 does not suggest use of treated foam in contact with food articles (Br. 15).

The Examiner contends that Zabron shows that surfaces that come into contact with food may desirably contain an anti-microbial agent, and that one of ordinary skill in this art would have recognized the benefit of incorporating an anti-microbial agent into food-contacting surfaces (Answer 12).

The Examiner contends that JP '841 discloses foam padding with an anti-microbial agent incorporated therein to inhibit the growth of bacteria on surfaces recognized as being at risk (Answer 12).

Accordingly, we determine the following issues presented from the record in this appeal: (1) Has the Examiner established that Appellant was not in possession of the concept of including a flexible outer layer of vinyl to reduce the absorption of moisture by the foam padding?; (2) Has the Examiner established that foam padding on surfaces of a produce handling machine to mitigate bruising of the produce was known from the prior art?; (3) Has the Examiner established that adding an anti-microbial agent to a

foam padding to inhibit the growth of bacteria was known in the prior art?; and (4) Has the Examiner identified proper reasons for combining these known elements in the manner claimed?

We determine that the Examiner has not established a prima facie case of lack of written description essentially for the reasons stated in the Brief, Reply Brief, and for those reasons set forth below. Therefore, we REVERSE the rejection of claim 7 under the first paragraph of § 112.

We determine that the Examiner has established a prima facie case of obviousness in view of the reference evidence, which prima facie case has not been adequately rebutted by Appellant's arguments. Therefore, we AFFIRM all grounds of rejection based on § 103(a) essentially for the reasons stated in the Answer, as well as those reasons set forth below.

The decision of the Examiner is thus AFFIRMED.

OPINION

A. The Rejection under § 112, ¶1

The Examiner finds that the Specification discloses that the purpose of the vinyl layer (810) is to provide abrasion resistance and thus there does not appear to be support for the recitation in claim 7 that the vinyl layer reduces the absorption of moisture by the foam padding (Answer 3, citing the Specification 9:17-27).

An *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the applicant had possession of the subject matter in question as of the filing date of the application. See *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19

USPQ2d 1111, 1117 (Fed. Cir. 1991). We agree with Appellant that the disclosure in the Specification (9:20-27) that the foam padding layer further includes a flexible outer vinyl layer to provide abrasion resistance would have reasonably conveyed to one of ordinary skill in the art that this outer vinyl layer must necessarily reduce, to some extent, the absorption of moisture by the inner foam padding layer. We determine that the Examiner has not established that the originally filed disclosure would not have reasonably conveyed to one of ordinary skill in the art that Appellant had possession of the now claimed subject matter. *See Ex parte Parks*, 30 USPQ2d 1234, 1236 (BPAI 1993). Therefore, we cannot sustain the rejection of claim 7 for lack of written description under the first paragraph of § 112.

B. The Rejections based on § 103(a)

We determine the following factual findings from the record in this appeal:

- (1) Smith discloses a produce (egg) handling machine comprising a stationary produce-contacting surface (the feeder drum) on which is attached foam (sponge rubber) padding to protect the produce (eggs) (Answer 4; Smith, col. 1, ll. 3-5; col. 2, ll. 30-36, 40-44, and 54; and col. 3, ll. 32, 47-48, and 57);
- (2) Schnider discloses a produce (egg) handling machine including a stationary produce-contacting surface (tray 62) including a foam (sponge rubber) padding to reduce breakage (Answer 5; Schnider, col. 2, ll. 40-44);

- (3) Ross discloses a produce (fruit) handling machine including numerous food-contacting surfaces and stationary surfaces which include foam rubber or other suitable foamed plastic to reduce bruising of the produce (Answer 5-6; Ross, col. 1, ll. 21-23 and 45-49; col. 3, ll. 4-12; col. 4, ll. 43-45; col. 6, ll. 2-6 and 39-46; and col. 7, ll. 19-21);
- (4) Boyle discloses a produce handling machine including a stationary produce-contacting surface including a foam padding to reduce bruising of the produce (Answer 6; Boyle, Abstract; col. 1, ll. 13-17 and 44-65; and col. 2, ll. 54-56);
- (5) Moore discloses a produce handling machine comprising a receiver, a produce washer, a dryer unit of the absorbing type, with numerous fixed and moving produce-contacting surfaces (Answer 7; Moore, 1:1-4; and Figs. 1 and 1);
- (6) Kurtz discloses the well known provision of a drape at the exit of a produce (egg) washer (Answer 9; Kurtz, col. 1, ll. 13-14; and col. 2, ll. 33-36);
- (7) Bowman discloses a produce washer including rubber scrubbing members (Answer 9; Bowman, page 1, left col., ll. 4-7; page 1, right col., l. 48-page 2, left col., l. 5; and page 2, left col., ll. 38-40);
- (8) Butterworth discloses a produce washer with nylon bristles (Answer 10; Butterworth, col. 3, ll. 21-23);

- (9) Newhall discloses a produce dryer including an open cell foam roller as well as wringers (Answer 10; Newhall, col. 1, ll. 1-6 and 36-47; and col. 2, ll. 17-28);
- (10) Zabron discloses that, if a belting is intended to be used to convey food grade products, preferably an antibacterial agent is incorporated into the elastomeric material of the belt to inhibit bacterial growth and promote asepsis on the food-contacting surface (Answer 4; Zabron, Abstract; col. 1, ll. 26-29; col. 6, ll. 44-60; and col. 7, ll. 5-10);
- (11) Zabron teaches that other textile layers associated with the belting can also have an antimicrobial agent incorporated therein (col. 1, ll. 29-31 and 41-44); and
- (12) JP '841 discloses a method of conferring bacterial/fungal resistance to polyurethane foam by immersing the foam in an aqueous solution of an antibacterial agent (Answer 4; JP '841, page 2, ¶¶ (54) and (57)); and
- (13) JP '841 teaches the well known necessity of conferring bacterial resistance to many types of products; JP '841 further teaches that polyurethane foams particularly are useful in many diverse fields "by virtue of their light weights and excellent cushion potentials" (3: ¶¶ [0002] and [0003]).

Under 35 U.S.C. § 103, the factual inquiry into obviousness requires a determination of: (1) the scope and content of the prior art; (2) the differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) secondary considerations. *See Graham v.*

John Deere of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). “[A]nalysis [of whether the subject matter of a claim is obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007), quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006). As held by the Supreme Court in *KSR*, 127 S. Ct. at 1739, 82 USPQ2d at 1395:

Neither the enactment of § 103 nor the analysis in *Graham* disturbed this Court’s earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art. For over a half century, the Court has held that a “patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men.” *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, [340 U.S. 147, 152 (1950)]. This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

Furthermore, the Court reiterated its holding in *KSR* by stating that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 127 S. Ct. at 1739-40, 82 USPQ2d at 1396.

Applying the preceding legal principles to the factual findings in the record of this appeal, we determine that the Examiner has established a *prima facie* case of obviousness in view of the reference evidence, which

prima facie case has not been adequately rebutted by Appellant's arguments. First, we note that Appellant admits that use of foam padding to reduce bruising of produce in produce handling machines was known in the prior art (Specification 1:5-24; *see also* Answer 16). As shown by factual findings (1) through (4) listed above, we determine that the applied prior art establishes that the use of foam padding on at least one stationary produce-contacting surface to reduce damage to the produce was well known in this art. Second, we note that Appellant admits that the inclusion of antibacterial agents in various materials to inhibit the growth of bacteria was well known (Specification 1:28-2:21; *see also* the commercial products listed at Specification 7:19-23 and the disclosure at 7:31-8:4). As shown by factual findings (10) and (12) listed above, we determine that the applied prior art establishes that the incorporation of antibacterial agents with foam padding to inhibit or retard the growth of bacteria on a food-contacting surface was well known in the art. Furthermore, we determine that Zabron teaches that the incorporation of an antibacterial agent can be expanded into other materials (*see* factual finding (11) listed above).

Thus, we determine that it would have been within the ordinary skill in this art to have employed the foam padding with an antimicrobial agent, as taught by Zabron, with any food-contacting member in a produce handling machine for the benefit taught by Zabron (*see* the Answer 12). We also determine that JP '841 teaches that polyurethane foam has many diverse uses but is beneficial for its light weight and cushioning effect (*see* factual finding (13) listed above). Therefore, we determine that one of ordinary skill in this art would have used the polyurethane foam with an antibacterial agent, as taught by JP '841, for its light weight and cushioning effect in the

produce handling machines of the primary references to reduce damage to the produce. We determine that the claimed subject matter merely combines familiar elements according to known methods and does no more than yield predictable results. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. at 1739, 82 USPQ2d at 1395.

With regard to Appellant's separate arguments for claims 16 and 18 (Br. 20), we adopt the response of the Examiner (Answer 14). With regard to the separate arguments against Boyle (Br. 20-21), we adopt the Examiner's response (Answer 14-15). In response to Appellant's argument against Moore (Br. 22), we note again that the use of foam padding to reduce damage to the produce was admittedly well known. With regard to the argument against claims 22 and 24, we note that Appellant admits that these antibacterial agents were known in the art (Specification 7:24-8:6). With regard to Appellant's other arguments concerning specific dependent claims, we refer to and adopt the Examiner's response (Answer 15-19).

For the foregoing reasons and those stated in the Answer, we affirm every ground of rejection based on § 103(a) presented for review in this appeal.

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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PL initials:
sld

BASCH & NICKERSON LLP
1777 PENFIELD ROAD
PENFIELD, NY 14526